

REMARKS

Reconsideration of the restriction requirement of the present application is respectfully requested.

Status of the Claims

Claims 1-7 and 19-41 have been acted upon by the Examiner. Claims 34 and 35 have been amended. No claims have been added or canceled. Accordingly, Claims 1-7 and 19-41 are presented for examination.

Restriction Requirement

Applicants elect the claims of Group I with traversal. As grouped by the Examiner, Group I contains Claims 1-4, 20, 22, 24, 26, 28, 30, 32, 33, 35-36, 38, and 40.

The Examiner alleges that “Applicant’s inventions do not contribute a special technical feature when viewed over the prior art,” and therefore, “they do not have [a] single general inventive concept and lack unity of invention.” As a result, the Examiner divided the claims into nine groups. The groups of claims have been divided based on the type of fusion protein that is being used in the claimed method.

First, Applicants note that Group I should contain Claim 34 rather than Claims 33 and 35. Prior to amendment, Claim 34 had depended indirectly on Claim 1, which is the basis for Group I. Claim 34 has been amended to directly depend from Claim 1. Claims 33 and 35 depend indirectly on Claim 5 which is the basis for the other 8 groups. Claim 35 has been amended to depend directly on Claim 5. Accordingly, Group I should include Claims 1-4, 20, 22, 24, 26, 28, 30, 32, 34, 36, 38, and 40.

Second, the basis for the Examiner’s application of the Gayle et al. publication (J. Clin. Invest 101(9):1851-1859, May 1998) to the restriction requirement is not clear to Applicants. Applicants provided this reference in an IDS filed on July 24, 2002. If the Examiner is asserting a § 102 or § 103 rejection of the claims over Gayle et al., Applicants

believe they will be able to overcome the rejection because Gayle et al. describes Applicant's own work.¹

Third, Applicants traverse the restriction requirement as the nine groups of claims are within the unity of invention standards as set forth in the PCT rules, 37 C.F.R. § 1.475, and MPEP § 1850. Unity of invention is found where there is "a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features." PCT Rule 13.2; MPEP § 1850. "Special technical features" means "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." PCT Rule 13.2; MPEP § 1850.

Here, the Examiner appears to be arguing that since Applicants' claimed invention does not contribute a special technical feature over the prior art, they do not have a single general inventive concept and lack unity of invention. Applicants respectfully submit that the Examiner is misapplying the PCT unity of invention standard. MPEP § 1850 provides that the prior art is to be considered when determining whether two or more dependent claims contain a single general inventive concept when the independent claim is found to be lacking novelty or inventive step over the prior art.

Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step. For example, a document discovered in the international search shows that there is a presumption of lack of novelty or inventive step in a main claim, so that there may be no technical relationship left over the prior art among the claimed inventions involving one or more of the same or corresponding special technical features, leaving two or more dependent claims without a single general inventive concept.

Without any analysis, the Examiner has asserted that each one of Applicants' claims do not contribute a special technical feature over Gayle et al. As explained above, Applicants believe they will be able to remove Gayle et al. as prior art. In any event, the Examiner is misapplying the unity of invention standard by applying the reference to *each* of Applicants' claims. Any prior art should be applied to the independent claims in order to determine

¹ On July 20, 2005, Applicants phoned the Examiner to determine whether it would be proper to submit a declaration overcoming the Gayle et al. publication at this time. The Examiner informed Applicants that it would not be proper at this time and that any declaration should be submitted in response to a rejection of the claims.

whether the corresponding dependent claims still contain an inventive link. See MPEP § 1850 (“If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered.”). Accordingly, Gayle et al. cannot be the basis for a valid restriction requirement.

Under the proper standard, the claims of the present application all share a single inventive concept as they are all directed to methods for using novel and non-obvious fusion polypeptides. Each of the claim groups defines a method for using a fusion polypeptide that contains at its C-terminal portion soluable CD39. Accordingly, the special technical feature of each claim group is the use of a fusion protein containing at its C-terminal portion soluable CD39 in methods for inhibiting platelet activation and recruitment in a mammal (Claims 1-7 and 20-41) or for degrading nucleoside tri- and/or di- phosphates (Claim 19), which is thought to be the mechanism that inhibits platelet activation. The claim groups only differ with respect to the N-terminal portion of the fusion polypeptide that is used in the claimed method. The various N-terminal portions used in the claim groups all have the same function of promoting the extracellular secretion of the polypeptide. Accordingly, the use of these particular fusion polypeptides is the single general inventive concept that links the claim groups together.

Moreover, the Examiner who completed the PCT Written Opinion did not find lack of unity in the claims even though claims 1-20 as originally filed contained the same types of inventions. See PCT Written Opinion dated August 18, 2000. The claims as now amended retain the same technical relationship as the original claims.

For the reasons given above, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement.

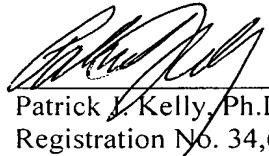
SYNNESTVEDT & LECHNER LLP

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U.S. Application No. 09/807,660

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The Commissioner is authorized hereby to charge any fees or credit any overpayment associated with this Reply (copy enclosed) to Deposit Account Number 19-5425.

Respectfully submitted,



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